

REMARKS

Applicant thanks the Examiner for his diligent and thorough review of the prior art of record and the pending claims and the Applicant's previous remarks. Applicant also thanks the Examiner for withdrawing the previous rejection under 35 U.S.C. § 101.

In the Final Office Action ("FOA"), claims 1-62 were rejected as being unpatentable under 35 U.S.C § 103(a) over Zervides (US6052674) in view of Crapo (2004/0064371). Applicant contends that each of the amended and presently pending claims are patentable over this cited combination of references for the following reasons.

Claim 1 has been amended to specifically recite that the claimed process is an "award process" that uses accounts receivable information "communicated to an Administrator of an award system implementing the award process," that the "identification of an eligible Recipient" is received "from a Sponsor," and "the identification of at least one qualified account receivable is based upon the timely payment of an accounts receivable to the Sponsor ..." Thus, Applicant has specifically amended claim 1 to recite a process executed by an Administrator of an "award system" and not a process executed by Zervides or a Sponsor, i.e., an "invoicing system."

As previously asserted in response to the previous Office Action, Applicant understands Zervides as teaching an invoicing system, i.e., a system that generates invoices and records the payment of the same. As amended in claim 1, these accounts receivables processing functions are accomplished by a Sponsor. In contrast, claim 1 recites an award process that utilizes information output from an accounts receivable system by a Sponsor, but does not itself attend to or accomplish the function of invoicing, ledgering and otherwise processing accounts receivables.

More specifically, the FOA provides that Zervides teaches "systems and methods for encouraging customers of suppliers to pay their bills on time." (OA, p. 2, lines 15-16.) Claim 1 does not recite a system or process for "encouraging customers ... to pay ... bills" – it recites a process for awarding good behavior that has already occurred. Thus, clarification as to the importance of this statement is requested.

Further, the FOA asserts that "A central host (EICS) is made aware of customer invoices by way of suppliers electronically transmitting data over the Internet [fig 11:: 142, 144, col 7 lines 51-62]." Yet, the passage at 7:51-62 refers to a method "initiated by the transfer of invoice 110 from supplier 102 to EICS 100 via the internet or facsimile..." (emphasis added) This passage

does not teach "an identification of an eligible Recipient ... [or] an identification of at least one qualified account receivable ... wherein the identification ... is based on the timely payment of an accounts receivable", as recited in claim 1. Further, one of ordinary skill would understand that an invoice is sent before an accounts receivable is commonly paid and thus the sending of the invoice to the EICS can not accomplish the recited operation of "identifying an eligible Recipient" or "receiving an identification of at least one qualified account receivable." To assert that it so teaches is tantamount to putting the cart before the horse.

Nonetheless, this passage from Zervides appears to be the one upon which the FOA's "Response to Arguments" section relies. Specifically, the FOA states that "Applicant argues that the art does not show electronically receiving an identification of an eligible recipient. Examiner disagrees – Zervides et al shows the EICS electronically receiving the invoicing data regarding the customers...." (FOA, page 7, line 16 to page 8, line 2.) Again, the passage relied upon in the FOA, when applied to the process of claim 1, essentially teaches an element that is not recited therein and does not occur in the invention recited in claim 1, i.e., the providing of an invoice by a Sponsor to an Administrator. Claim 1 recites "electronically receiving an identification of an eligible Recipient" (i.e., one who has timely paid previous accounts receivable – which were presumably invoices per common accounting procedures). Claim 1 does not recite receiving an identification of one who has an outstanding invoice or for whom an invoice needs to be generated. Thus, Zervides teaching of this non-recited limitation is simply irrelevant. Providing an invoice is not tantamount to "electronically receiving an identification of an eligible Recipient." Thus, regardless of whether the invoice is communicated manually or electronically to the EICS, a prima facie case of Zervides teaching the limitation of "receiving an identification of an eligible Recipient" has not been set forth.

Further, the FOA provides that: "The EICS also electronically receives customer invoice payment data and stores such user history data in customer accounts in the computerized EICS database [fig 11, element 138]." The relevance of this teaching to the claimed limitations is not clear to Applicant. The claim does not recite the receiving, let alone storing, of invoices, payment data, accounts receivables or the like. Instead, claim 1 recites, in part, "... receiving an identification of an eligible Recipient; ... receiving an identification of at least one qualified account receivable ... generating an award [based on the received information]... and transmitting ... the award to the Recipient." Thus, clarification is needed as to why this teaching of Zervides is important in the context of claim 1.

The FOA then acknowledges that Zervides does not teach a system for awarding good payment behavior and instead, at best, provides only a punishment mechanism. Reliance (in a previous OA and presumably in this FOA) is then placed upon manual systems and Crapo's teachings to presumably teach the elements of "generating an award ..." and "transmitting ... the award" The basis for this reliance upon Crapo is again misplaced because as previously explained in response to the last Office Action, Crapo teaches the awarding of credits for user on-line activity. That is, the more often the user clicks to an on-line web page/service (presumably hosted by Crapo's system), the more credits the user gets. By analogy, Crapo's system is tantamount to an airline offering a discount for booking air travel on-line versus via telephone. Claim 1 does not recite a process by which a user gets a credit simply because they accessed the system facilitating the award processing.

Further and for sake of argument only, even if one of ordinary skill combined Zervides with Crapo they would not arrive at the invention of claim 1 (i.e., a process for "generating an award based upon the amount of the at least one qualified account receivable"). Instead, they would arrive at a system/process wherein the payee would receive some credit for using the EICS system to pay their invoices. Per Crapo, use of the Zervides EICS system would generate a credit. Crapo does not teach, mention or suggest that an award would be given to a Recipient for an account receivable that is identified as a "qualified account receivable" based upon "timely payment of an accounts receivable" as recited in claim 1. Since claim 1 recites an award process for Recipients of "qualified account receivable[s]" and not an award process for frequent users of an on-line service (as perhaps suggested by the combined prior art), claim 1 is patentable over Zervides in view of Crapo.

Further, claim 1 has been amended to recite that the "identification of an eligible Recipient" is by a Sponsor and is "based upon a Sponsor determined criteria." Likewise, claim 1 further recites that the step of "paying the Administrator a monthly fee corresponding to a value associated with at least one award redeemed by the Recipient." The cited prior art does not teach this combination of elements and thus claim 1 is patentable over Zervides in view of Crapo.

Claims 2-9 depend from claim 1 and thus are patentable for the above reasons.

Also, claim 2 has been amended to further distinguish between an awards process and Zervides' invoicing process. For at least this reason, claim 2 is patentable over Zervides in view of Crapo.

Claim 5 has also been amended to further recite that the designation of a customer as an eligible Recipient is based, at least in part, upon a Sponsor accessing a computer database, searching the database and identifying those customers who "have timely paid any billed charges on two or more invoices." It is Applicant's understanding that Zervides system does not use historical payment information to determine the surcharges added to any given invoice. As such, claim 5 is patentable over Zervides in view of Crapo because neither Zervides nor Crapo teach this limitation and/or combination of limitations.

Claim 6 has been amended to recite that the computer implemented process also comprises "maintaining a list of prospective customers identified by a Sponsor." Upon belief, neither Zervides nor Crapo teach this limitation. Thus, for at least the above reasons, claim 6 is patentable over Zervides in view of Crapo.

Claim 10 recites numerous limitations that simply are not addressed in the FOA. In fact, claim 10 includes at least 9 elements. Of these the Examiner has addressed only one by stating "identifying the amount due on the bill is taken to provide identifying the amount of accounts receivable qualified to receive a credit." (FOA, p. 3, lines 20-21.) This statement does not set forth a prima facie case of unpatentability because it does not show where each of the elements of claim 10 are taught by the prior art. Further, even for the element addressed (i.e., "identifying the amount of accounts receivables ...") no reference to the teachings in Zervides, Crapo or any other reference is provided.

Further, "identifying the amount on the bill" does not teach, mention or suggest the action of "identifying the amount of accounts receivables qualified to receive a credit ..." as recited in claim 10, because a billed amount and an accounts receivable amount may vary. For example, companies often give discounts for early payment, such discount would not be reflected on the bill (because the early payment has not occurred and the discount not accrued). But, the discount could be reflected in the "amount of accounts receivable qualified to receive a credit." Thus, since a prima facie case has not been set forth, the rejection of claim 10 as being unpatentable over Zervides in view of Crapo should be withdrawn.

Also, claim 10 has been amended to further recite “paying a monthly fee corresponding to a value associated with at least one credit redeemed by a customer.” Neither Zervides nor Crapo teach this limitation or this limitation combined with the other recited limitations. Therefore, for at least this additional reason, claim 10 is patentable over Zervides in view of Crapo.

Claims 11 and 13 each depend from claim 10 and thus are patentable for the above reasons. Further, claim 11 as amended recites that: “the travel agency and the system are hosted by a single computer.” Zervides in view of Crapo does not teach this single computer implementation, thus, for at least this reason, claim 11 is patentable over Zervides in view of Crapo.

Claim 13 recites that “the customer, an Administrator and a Sponsor are notified each time a credit is added, saved or deleted to the account.” In rejecting this limitation, the Examiner relies upon Crapo, paragraph 40. Yet, paragraph 40 teaches that a user can have on-line access to their “WebMiles” account information. Crapo in paragraph 40 does not teach that “the customer [let alone the Administrator and the Sponsor] is notified each time a credit is saved to the account.” Thus, the Examiner has not set forth a prima facie case of obviousness. For at least these reasons, claim 13 is patentable over Zervides in view of Crapo.

Similarly, a prima facie case of unpatentability has not been set forth for claim 16. Instead, the FOA simply states “Crapo teaches that users having enough credits and desiring to redeem them can engage in a redemption process with a redemption center (a travel agency/service). [¶ 40].” This statement is non-specific to any claim element and thus does not set forth a prima facie case. For at least this reason, withdrawal of the rejection of claim 16 is requested. Further, claim 16 has been amended to recite additional limitations that, upon belief, are not taught by the combination of Zervides in view of Crapo, such as: “determining a goods/services to be purchased by a Recipient from a third party vendor wherein the Recipient specifies at least one preference to the system, the preference being used by the system to identify at least one third party vendor; [and] electronically identifying the third party vendor to the system by selecting the third party vendor from a listing of third party vendors registered with the system.” For at least these reasons, claim 16 is patentable over Zervides in view of Crapo.

Also, claim 16 has been further amended to recite that “the Recipient specifies at least one preference to the system, the preference being used by the system to identify at least one

third party vendor." Zervides in view of Crapo do not teach this limitation and/or combination of limitations. Therefore, claim 16 is patentable over the cited prior art for at least this reason.

Claim 16 has further been amended to recite that the "credits are awarded ... based upon the identification of the Recipient as a best customer by a Sponsor." Zervides and Crapo do not teach this identification. Hence, claim 16 is patentable over Zervides in view of Crapo.

Claim 18 depends from claim 16 and thus is patentable for the above reasons.

Similar to independent claims 10 and 16, a prima facie case of unpatentability of claim 19 has not been set forth in the FOA. Therefore, withdrawal of the same is respectfully requested. Further, claim 19 recites a process for awarding credits based upon "a Sponsor specified set of criteria which at least includes the timely payment of an accounts receivable." For all the reasons stated above, Zervides in view of Crapo do not teach this limitation and/or combination of limitations. Thus, for at least this reason, claim 19 is patentable.

Further, claim 19 has been amended to recite "identifying a prospective Recipient to the system." This limitation is not taught by Zervides or Crapo. Thus, for at least these reasons, claim 19 is patentable over Zervides in view of Crapo.

Claims 20-24 depend from claim 19 and thus are patentable for the above reasons.

Last, claims 12, 14, 15, 17 and 25-62 have been cancelled in order to streamline the issues pending before the Examiner. Nonetheless, these claims – should they be later pursued in this or a related application - are also patentable for essentially the same reasons as the above discussed claims are patentable. Applicant preserves the right to pursue these cancelled claims and/or other claims in this or other related applications.

In closing, in view of the above amendments and remarks, each of the pending claims is patentable over the cited combination of Zervides in view of Crapo. Therefore, allowance of all pending claims is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, a Notice of Allowance is earnestly solicited.

This Request for Continued Examination, Amendment and Response to Final Office Action is being filed with a Petition for a One-Month Extension of Time and a request to charge Deposit Account No. 04-1415 for the extension of time fees and any additional excess claim fees. Applicant does not believe that any other fees are required with this Amendment and Response, but if such fees are required, please consider this authorization to charge such fees to the above Deposit Account.

As always, if the Examiner has any questions or concerns, or believes that a personal or telephonic interview will expedite prosecution, the Examiner is strongly encouraged to contact patent attorney Brian Laurenzo, of Dorsey & Whitney's Des Moines office, at 515-699-3286. The Examiner should note that as of August 31, 2006, the undersigned attorney will be leaving Dorsey & Whitney LLP to pursue an in-house legal position and will no longer be representing the Applicant.

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